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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/612,128 03/07/96 CALANDRA

F 960273

C5M1/1122

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EXAMINER

TAYLOR, D

ART UNIT

PAPER NUMBER

3506

DATE MAILED:

11/22/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Art Unit: 3506

Part III DETAILED ACTION

Reissue Oath or declaration requirements.

37 CFR 1.175; Reissue oath or declaration

Applicant must:

a(1). When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why;

a(2). When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing", particularly specifying such defects;

a(3). When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent", distinctly specifying the excess or insufficiency in the claims;

a(4). [Reserved]

a(5). Particularly specifying the errors relied upon, and how they arose or occurred;

a(6). Stating that said errors arose "without any deceptive intention" on the part of the applicant;

a(7). Acknowledging the duty to disclose to the Office all information known to applicants to be material to patentability as defined in § 1.56;

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Oath/Declaration

The reissue oath or Declaration filed with this application is objected to as being defective.

As to Rule 1.175(a)(3) + (a)(5), when it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," the excess or insufficiency of the claim(s) must be **distinctly specified** by stating:

1). What the defects are (a)(3);, i.e.,

each and every change in the specification or claims must be supported in either the original or a supplemental oath or declaration. Every departure from the original patent represents an "error" in the original patent under 35 USC 251 and must be particularly and distinctly specified and supported in the original or a supplemental reissue oath or declaration under 37 CFR 1.175. Note In re Constant, 3 USPQ 2D 1479 and MPEP 1444.

2). How the defects arose (a)(5); i.e.,

what are the facts that led up to circumstances which caused the defect(s).

3). When the defects arose (a)(5);

4). How the defects were discovered (a)(5);

5. When the defects were discovered (a)(5).

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ASSENT

The Assent is defective. The Assent must:

establish ownership by;

a) (1). Submitting to the Office copies of the documentary evidence of a chain of title from the original inventor to the assignee, or

(2). Specifying, by reel and frame number, for example, where such documentary evidence is recorded in the Office.

b). There is further requirement that the Assignee submit a statement specifying that the evidentiary documents have been reviewed and certifying that, to the best of the Assignee's knowledge and belief, title is in the Assignee seeking to take action.

c). The statement under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following two manners if the assignee is an organization(e.g., Corporation, partnership, university, government agencies, etc.);

1). The statement may be signed by a person in the organization. An officer (president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization; or

2). The statement may be signed by any person, if the statement includes an averment that the person is

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empowered to sign the statement on behalf of the assignee and, if not signed by a registered practitioner, the statement must be in oath or declaration form.

Applicants ASSENT fails to comply with b) above.

Claims 1-24 are rejected as being based upon a defective reissue Declaration under 35 USC 251, for reasons as set forth above.

Reissue Oath or Declaration how the errors arose

Claims 1-24 are considered to be rejectable under 35 USC 251 as being based on a defective reissue declaration. 37 CFR 1.175(a)(5). Applicant(s) declaration fails to comply with the requirement that Applicants specify "how the error arose or occurred".

There does not appear to be any statement in Applicant(s) declaration relative to "how the error arose". Applicants state, page 1 of the Declaration, par. 7;

"Specifically, claims 1 to 20 claim less than we had a right to claim because they do not claim the full scope of the invention. The specification contains several typographical errors, and Figs. 1 and 2 lack reference numeral 84.

This statement merely represents a conclusion and lacks a description of the facts leading up to the conclusion that there was a lack of appreciation of the invention.

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The requirements of the rule (37 CFR 1.175) have been amplified and embellished by the PTO in the MPEP at Sec. 1414, wherein it is stated

"Reissue oaths or declarations must point out very specifically what the defects are and how and when the errors arose, and how and when the errors were discovered".

Failure to appreciate the full scope of the invention has been deemed to be acceptable by the CAFC as a basis for reissue, when accompanied by adequate factual support in the form of affidavits by others involved in the prosecution of the original patent application. See In re Wilder, 222 USPQ 369. In the instant application, the reissue declaration does not even state who lacked an appreciation of the scope of the invention.

The CAFC has recognized the significance of the rule requirements in decisions following Wilder. See Hewlett-Packard v. Bausch & Lomb, 11 USPQ2d 1750 at 1758:

The statutory provision has been implemented and expanded by the PTO regulations of 37 CFR 1.175, which require an oath or declaration with respect to both aspects of error under section 251 and further require an explanation as to how and when the error in conduct arose and how and when it was discovered.

Additionally, the court footnoted in In re Weiler, 229 USPQ at 677 (footnote 4):

Weiler's reliance on allegations of the inventors' ignorance of drafting and claiming technique and counsel's ignorance of the invention is unavailing. Those allegations

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could be frequently made, and, if accepted as establishing error, would require the grant of reissues on anything and everything mentioned in a disclosure. Weiler supplies no facts indicating how the ignorance relied on caused any error as the basis for his failure to claim the subject matter at claims 13 and 19.

supporting the theory that boiler-plate language in the oaths or declarations would not suffice.

That the PTO Board of Appeals is following the tenor of the court on this issue can be seen in the recent decision of Ex parte Murakami, p. 4, last line:

"The court thus gives great deference to the requirement of explanation as to how and when any error in conduct arose and how and when it was discovered".

See also Alcon Laboratories v. Allergan Inc., 17 USPQ2d 1365 at 1375.

Claims 1-24 appear to contain allowable subject matter and will be allowed pending a perfected reissue declaration.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Taylor whose **telephone number is (703) 308-1013**. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

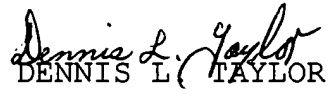
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tamara Graysay, can be reached on (703) 308-2144. The **fax phone number for this Group is (703) 305-3597 or 305-3598**.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.


DENNIS L. TAYLOR
PRIMARY EXAMINER
ART UNIT 3506

November 21, 1996
(6) 612128.1st